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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,374	04/15/2004	Yuichiro Uchida	072955-0103	6627

22428 7590 03/02/2007  
FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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LEFF, STEVEN N

ART UNIT	PAPER NUMBER
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1761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/824,374

Applicant(s)

UCHIDA, YUICHIRO

Examiner

Steven Leff

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 1-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/15/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

- Claims 1-13 contain numerous grammatical errors in addition to the 35 USC § 112 rejections listed below which cause the meets and bounds of the claims to be unclear.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - Claims 1-13 are rejected due to the fact that it appears claims 1-9 are drawn to packaging a sushi product, claims <sup>10</sup>10 and 11 are drawn to the sushi product itself not in conjunction with the packaging, and claims 12 and 13 are drawn to the packaged sushi product of claim 1 or a sushi product alone as the end product. It is unclear as to whether the applicant is claiming the production of sushi or the production of a packaged sushi product. Applicant is encouraged to maintain consistent terminology throughout the entire set of claims. For example, claims 12 and 13 recite the phrase “the edible kelp rolled sushi or the edible kelp rolled sushi packaged with a shape-keeping film,” thus clearly distinguishing a difference between the packaged sushi and the sushi itself. The end product of claim 1 is a packaged sushi product not the sushi itself and therefore the phrase “the edible kelp rolled sushi” of claims 12 and 13 lacks antecedent basis.
  - Claim 1 is rejected due to the phrase “rolling a sushi body.” It is unclear as to how the identified “sushi” in the preamble and the “sushi body” recited on line 2 are different. For example, the sushi body could be a protein product such as fish, or it could be meant to represent the fish and rice already combined together thus forming a sushi body.
  - Claim 1 is further rejected due to the phrase “seasoning treated sushi material”. The phrase is indefinite due to the fact that it may represent that the sushi “material” may be seasoned and treated or the seasoning of the sushi body may be the treatment.

- Claim 1 is further rejected due to the phrase “combined together in a cooked edible kelp to form an edible kelp rolled sushi.” The phrase is indefinite due to the fact that it may represent that the combined sushi product is actually rolled while within the kelp, or if the sushi product and rice are previously rolled prior placement on the kelp where folding the sides of the kelp around the combined sushi product would constitute “an edible kelp rolled sushi.”
- Claim 1 is further rejected due to the phrase “combined together”. The phrase is indefinite due to the fact that it may represent that the sushi body may be completely covered by the rice, or the sushi body may merely sit on top of the rice.
- Claim 1 is further rejected due to the phrase “in adhesion”. The phrase is indefinite due to the fact that it may represent specifically “in adhesion” by using an adhesive or it may be meant to represent contacting.
- Claim 1 is further rejected due to the phrase “covering the whole surface of said edible kelp.” The phrase is indefinite due to the fact that it may represent that the kelp covers the whole upper surface, the whole bottom surface, the sides or the entire sushi product.
- Claims 1-4, 9, 12 and 13 are rejected due to the phrase “shape-keeping film”. The phrase is indefinite due to the fact that it may represent a pliable or flexible film, which stays in a flexible state, or could be meant to represent a film, which is more rigid and would permanently remain in a fixed state.
- Claims 1, and 2 are further rejected due to the phrase “seal-packaging”. The phrase is indefinite due to the fact that it is unclear whether the phrase is meant to represent seal-packaging the wrapped sushi product itself by treating the shape keeping film further or it may represent packaging the frozen sushi within a separate package and subsequently sealing the package.
- Claims 1, and 2 are further rejected due to the phrase “which has been covered” on line 9. The phrase is indefinite due to the fact that it may represent that the kelp covers the whole upper surface, the whole bottom surface, the sides or the entire sushi product.
- Claim 1 is further rejected due to the phrase “if necessary”. It is unclear as to how the phrase further limits the claim.
- Claim 2 is rejected due to the phrase “simple packaging material.” The phrase is indefinite due to the fact that it is unclear as to what would constitute the difference between a “simple packaging material” and packaging material in general.

- Claim 2 is further rejected due to the phrase “is packaged with a simple packaging material prior to seal-packaging.” The phrase is indefinite due to the fact that it may represent that the sushi product is actually packaged or wrapped by a simple packaging material in addition to being sealed within a separate “seal-package” or conversely the simple packaging material itself may be sealed to include the sushi product within itself.
- Claim 3 is rejected due to the fact that multiple parts of the claim appear to conflict with claim 1 from which it depends. For example in one instance, claim 3 positively states placing the kelp on a film, where claim 1 states covering the kelp with the film.
- Claim 3 is rejected due to the phrase “molded sushi body”. Claim 3 recites that the sushi body is the rice and sushi protein product combined where claim 1 recites the sushi body as only the sushi protein product.
- Claim 3 is further rejected due to the phrases “drawing in, contact bonding, and winding”. The phrases are indefinite due to the fact that it is unclear as to what would constitute “drawing in, contact bonding, and winding”. For instance drawing in could be meant to represent folding the edges inwardly or it could be meant to mean drawing them in through the use of a vacuum.
- Claim 3 is further rejected due to the phrases “film together with the edible kelp around the circumferential surface of the sushi body.” The phrase is indefinite due to the fact that it may represent winding the two together as one or winding both of the two separately with respect to the sushi product.
- Claim 3 is further rejected due to the phrase “laminating the both ends.” The phrase is indefinite due to the fact that it may represent actually laminating or covering both ends or it may be meant to represent sealing by bonding the ends together.
- Claim 3 is further rejected due to the phrase “onto the surface of the edible kelp rolled sushi and contact-bonding the ends...” The phrase is indefinite due to the fact that it may represent bonding the ends onto one of the kelp rolled sushi surfaces or it may be meant to represent contact bonding with respect to all of the axial surfaces.
- Claim 4 is rejected due to the phrase “the rolled and tightened strength of the shape keeping film is adjusted.” The phrase is indefinite due to the fact that it is unclear as to how the film is adjusted. For instance the film could be adjusted by treating, tearing, the degree of tightness with respect to the sushi product, etc.

- Claim 4 is further rejected due to the phrase “unitary feeling of hardness or elasticity together.” The phrases appear to conflict with one another.
- Claim 6 is rejected due to the phrase “synthetic bamboo sheath.” The phrase is indefinite due to the fact that it is unclear as what is meant to be represented by the phrase. For example the sheath could look like a piece of bamboo, or may be shaped as such.
- Claim 6 is further rejected due to the phrase “pillow package”. The phrase is indefinite due to the fact that it is unclear as what is meant to be represented by the phrase. For example the phrase could be meant to represent a particular type of packaging method with respect to how and where the package is sealed, or it could be meant to represent a specific shape where the package does not contact the sushi product continually on all of its sides.
- Claim 7 is rejected due to the phrase “has a shape for plural sushi pieces.” The phrase is indefinite due to the fact that it may represent a shape capable of being cut into plural pieces, or it may represent a shape capable of supporting different sushi pieces.
- Claim 8 is rejected due to the fact that it is unclear as to when the rolled sushi is thawed. For example, it could be thawed after the freezing with the film thereon or it could be meant to represent thawing takes place after the product has been packaged in a separate seal package and if necessary freeze stored.
- Claim 11 is rejected due to the phrase “it can be circulated at ordinary temperature.” The phrase is indefinite due to the fact that the word circulate may represent the actual distribution of the sushi product, or it could be meant to represent that the sushi can be eaten at ordinary temperatures.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-2, 4, 7-11 rejected under 35 U.S.C. 102(b) as being anticipated by Ishino et al.  
(5861184)

With respect to claims 1-2, 4, 7-11, Ishino et al. teach a method of packaging and thawing a sushi product. With respect to claims 1, 2, and 8-11 specifically, Ishino et al. teach rolling a sushi body (col. 8 line 50+) consisting of a treated sushi material and vinegared rice (col. 8 line 36+) in a cooked edible kelp (col. 7 line 16+) where the entire surface of the kelp rolled sushi is wrapped with a shape keeping film. (col. 8 line 53+) Subsequently, the film wrapped sushi is seal-packaged in simple packaging material (col. 8 line 56+) and if necessary frozen, (col. 8 line 59+) and thawed (col. 9 line 31+) thus allowing the sushi to be circulated at ordinary temperatures. (col. 4 line 61+) With respect to claim 2, and specifically the phrase "simple packaging material," Ishino et al. teach that the kelp and shape keeping film wrapped sushi is then inserted into a bag made of an inner polyethylene film which in the instant case is interpreted as a "simple packaging material", and an outer nylon film prior to seal-packaging. (col. 8 line 57+) It is noted that the term "seal-packaging" is interpreted with respect to claim 1 to mean when the bag or package is actually sealed from the surrounding environment. Therefore, Ishino et al. teaches packaging the covered rolled sushi with a "simple packaging material" prior to "seal-packaging".

With respect to claim 4, Ishino et al. teach that the rice and sushi material are pressed from above and compressed prior to being wrapped by the shape-keeping film, (col. 8 line 45+) and further figures 1-3 show at reference number 6 that the film is completely in contact with the sushi body. In the instant case the Office interprets that since the film of Ishino et al. is in contact with the sushi body and since the sushi product was compressed it would be inherent that "the rolled and tightened strength of the shape-keeping film is adjusted so that when eating sushi, vinegared rice has a unitary feeling of hardness or elasticity together with the kelp and sushi material."

Ishino et al. further teach with regards to claim 7, that the "edible kelp rolled sushi has a shape for plural sushi pieces," in the instance that the "shape for plural sushi pieces" (col. 4 line 15+) is meant to represent multiple packaged pieces, and Ishino et al. further teach sushi which is a shape capable of being cut into "plural sushi pieces."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1761

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino et al. in view of Clemente et al. (2337741)

Ishino et al. is taken as above.

With respect to claim 3, Clemente et al. teach a method of packaging, and the wrappers thereof in connection with such articles as cigars, food products, and the like having moisture content in the fresh state. (abstract) With respect more specifically to claim 3, Clemente et al. teach drawing in, contact bonding and winding the shape keeping film together around the circumferential surface of the body, laminating both ends of the rolled and tightened film, (pg. 2 col. 1 line 52+) and finally drawing in the remaining ends of the film at both sides in the axial direction and bonding the ends onto the exterior surface of the film. (pg. 2 col. 1 line 61+)

Although Ishino et al. does not teach the specific method of wrapping the sushi, Ishino et al. does teach wrapping a sushi product with a shape keeping film in order to maintain the freshness of the food product. In addition, Clemente et al., teach a method of wrapping food products where Clemente et al. does positively teach a specific method of wrapping with regards to the shape keeping film and Clemente et al. further teach sealing the shape keeping film thus maintaining the wrapper in a tight state with respect to the food product within. Consequently, since both Ishino et al., and Clemente et al. teach wrapping a food product in a shape keeping film for its art recognized and applicants' intended function of maintaining a food product in a particular state, one of ordinary skill in the art would have been motivated to combine the teachings of Ishino et al., and Clemente et al. in order to produce a wrapped sushi product which maintains desirable characteristics, such as freshness and which further ensures that the sushi product is maintained in a compact state during storage since the ends of the film are positively



sealed thus ensuring that the film does not unwind from the sushi product. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have produced a wrapped food product, where the wrapper is positively sealed with respect to the enclosed product.

- Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino et al. in view of Fujishima. (JP-55104867)

Ishino et al. is taken as above.

With respect to claim 5, Fujishima teaches a method of wrapping sushi. Specifically with respect to claim 5, Fujishima teaches an oxygen-removing agent being included within the seal package. (abstract) Therefore, although Ishino et al. does not teach an oxygen-removing agent within the seal-package, Ishino et al. does teach degassing and thermally sealing the sushi product within the pouch. (col. 8 line 57+) Further, both Ishino et al. and Fujishima teach maintaining a specific atmosphere within the sealed pouch for its art recognized and applicants intended function of removing gas(es), which promote spoilage of the sushi product. Fujishima continues by specifically stating "that the interior of the package is kept under an oxygen-free state by substituting with inert gas or by enclosing a deoxidizing agent in the package," (abstract) and therefore, one of ordinary skill in the art would have been motivated to combine the teachings of Ishino et al. and Fujishima and produce a sushi package which included an oxygen-removing agent within thus maintaining the freshness and palatability of the sushi within the package and increasing the products shelf life. It further would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to have substituted the degassing method of Ishino et al. with an oxygen-removing agent within the package due to the fact that Fujishima positively teaches their substitution.

- Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino et al. in view of Yamashita. (JP-2001008647)

Ishino et al. is taken as above.

Regarding claim 6, Yamashita teaches a method of containing and wrapping a sushi product. More specifically Yamashita teaches preparing sushi by putting boiled crab on cooked rice within a vessel. After obtaining the sushi product Yamashita teaches removing the sushi from the vessel, cutting the sushi into plural pieces, and subsequently returning the pieces to the

container and then wrapping the container with a bamboo sheath. Therefore, although Ishino et al. does not teach wrapping the sushi with a bamboo sheath prior to packaging, Ishino et al. does teach wrapping the sushi product with more than just the single layer of shape keeping film. Further the bamboo sheath as recited in claim 6 does not perform a function which is necessary in order to maintain the freshness of the sushi product. Therefore one of ordinary skill in the art would have been motivated to combine the teachings of Ishino et al. and Yamashita and wrapped the sushi product with a natural or synthetic bamboo sheath in order to provide a more appealing wrapped product to the consumer and further to allow the package to visually represent that its contents are sushi due to the fact that bamboo sheaths are common within the realm of sushi for not only packaging but also rolling the sushi. In the instant after the wrapping of the sushi product with the shape keeping film, any of the subsequent layers of Ishino et al., regardless of the material which it is made of, may visually depict a bamboo sheath and thus the simple package would be a synthetic bamboo sheath. Further, since Yamashita teaches wrapping the container with the bamboo sheath one of ordinary skill in the art would have been motivated to simply place the sushi product covered by a natural or synthetic bamboo sheath in a seal package, thus maintaining the freshness of the sushi product for a longer period of time and thus increasing its shelf life and the amount of time which the sushi may be purchased and/or eaten.

Therefore with respect to claim 6 it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have wrapped the sushi product with a natural or synthetic bamboo sheath prior to seal packaging in order to provide a general representation of the packages contents without needing to read the label, and in addition it would have been obvious to place a natural or synthetic bamboo sheath within a seal package thus increasing the shelf life of the product.

- Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino et al. in view of Garwood. (4840271)

Ishino et al. is taken as above.

With respect to claims 12 and 13, Garwood teaches an improved package for containing meat, fish, or other food products. (col. 1 line 7+) More specifically Garwood teaches a method where food items are tightly packaged within a wrapping material and where substantially all of the atmospheric air is excluded. The tightly packaged food item, which is placed in a container,

Art Unit: 1761

is subsequently treated with a gas to increase the food items shelf life and finally the entire container with the food within is sealed. (col. 1 line 51+)

With respect specifically to claims 12 and 13 Garwood teaches that packaged in combination with the food item is an eating implement such as a plastic knife. Although Ishino et al. does not teach packaging a knife with the sushi product, Ishino et al. does teach packaging a food item which may be cut into smaller pieces. Further both Ishino et al. and Garwood teach packaging foods which require that the interior of the package be treated in a manner which would increase the shelf life of the product where the food item is a meat or fish. Therefore since both Ishino et al. and Garwood teach packaging food materials which may spoil over an amount of time and more specifically packaging food items which are to be consumed, one of ordinary skill in the art would have been motivated to combine the teachings of Ishino et al. and Garwood in order produce a packaged food item(s) which included a knife thus ensuring at the time of consumption that the consumer has a knife readily available and thus is able to not only cut the food item but do so in a neat manner thus making the package more convenient to the consumer. Further, the use specifically of a plastic knife would allow the consumer to merely throw away the knife after use thus avoiding the need to clean the utensil. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have produced a packaged sushi item, which included a plastic knife within the package thus increasing the overall convenience of the package.

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**